

REMARKS/ARGUMENTS

Anticipation - Section 102(b) Rejection

The Examining Attorney has rejected claims 1-9, 17, and 19-21 as being anticipated by Jannach (5,862,606). The Applicant respectfully requests the Examining Attorney reconsider the rejection based on the amendments to the claims set forth above, and the arguments set forth below.

The applicant submits that Jannach does not anticipate this invention for the following reasons:

1. Jannach is forced air convection, requiring a blower and airholes in what the examiner refers to as the framework; whereas this invention includes no forced air convection – but instead relies on natural convection. Jannach therefore is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention.

There is no anticipation by a prior patent not known or recognized as being capable of performing the function of the patented device, but rather the prior patent must itself do the teaching. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (1984); Edstrom-Carson & Co. v. Onsrud Machine Works, Inc., 129 U.S.P.Q. 457.

2. For the reasons related to the nature of the convection, Jannach does not disclose the purpose, means or mechanism that this invention discloses – instead requiring forced air convection and having a defined exit airflow passageway. There is no anticipation where a reference does not

disclose the purpose, means and mechanism for accomplishing the instant invention but rather is restricted to a limited and different means. Sperry Products, Inc. V. Aluminum Company of America, 120 U.S.P.Q. 362.

3. Jannach does not disclose each and every element of this invention – since Jannach requires forced air convection to function and does not have a defined exit airflow passageway. There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

102 Rejection of Claims 22-24 Based on Yentis

The Examining Attorney has rejected claims 22-24 as being anticipated by Yentis (2,098,735). The Applicant respectfully also requests the Examining Attorney reconsider the rejection based on the claims amendments set forth above, and the points, authorities and arguments set forth below.

Yentis does not provide define an exit airflow passageway or provide one which directs airflow upward out of the garment, boot or shoe.

There is therefore no anticipation by Yentis since it is not known or recognized as being capable of performing the function of the patented device, but rather the prior patent must itself do the teaching. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (1984); Edstrom-Carson & Co. v. Onsrud Machine Works, Inc., 129 U.S.P.Q. 457.

For the reasons stated above, the Yentis reference does not disclose each and every element of the claimed invention, as required for a *prima facie* case of anticipation, and as stated more fully above. There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

Obviousness - Section 103(a) Rejection

The Examiner has first rejected claims 10 and 11 as being unpatentable over Jannach alone. Since claims 10 and 11 are dependant on claim 1, and there is no anticipation of claim 1, not all of the elements of claims 10 and 11 are present upon which to base an obviousness rejection. Furthermore, the claims that claims 10 and 11 depend upon have been amended as stated above. Applicant, therefore, respectfully requests the Examiner reconsider the rejection because not all the elements are present.

Furthermore, there is no discussion of temperature difference in Jannach, and there is insufficient record or articulated, or a sufficient allegation of what is generally known in the art, to support a *prima facie* case of obviousness.

In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee*, 61 U.S.P.Q. 2d 1430, decided January 18, 2002, the Federal Circuit held:

... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the

record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Furthermore, there is nothing in the Jannach reference which suggests the desirability of a temperature differential and no indication that a temperature differential is even contemplated.

Prior Art Made of Record and Not Relied Upon

The Applicant notes the prior art made of record but not relied upon and asserts that for the reasons set forth above, the claims are allowable over the art made of record.

New Claims

Applicant has added new claims 25-28, which add no new matter, are dependent on prior independent claims and allowable for the same reasons set forth above.

Conclusion

Applicant therefore submits Claims 1-28 are in a position to proceed to allowance.

Applicant is submitting a Request for Continued Examination (RCE)
herewith as well as any required fees.

Respectfully submitted,

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